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REMARKS

In accordance with the foregoing, claims 1 and 12-17 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-5 and 7-18 are pending and under consideration. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §103(a)**Claims 1-4, 7, 9-12, 14-17, and 18**

In the Office Action at page 2, claims 1-4, 7, 9-12, and 14-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,366,298 to Haitsuka et al. in view of U.S. Patent No. 6,236,330 to Cohen and further in view of U.S. Patent No. 5,250,910 to McGregor et al. This rejection is respectfully traversed.

Independent claims 1 recites "determining a passage count of the mobile client in a predetermined advertising information transmission area in which a position indicated by the position information is located and storing the passage count, the passage count including a number of times the mobile client passes within the predetermined advertising information transmission area, and when the mobile client passes through the same transmission area two or more times within a predetermined period of time, the second passage and later within that predetermined period of time are not counted." Similar features are recited in independent claims 12 and 14-17.

At pages 17-18 of the Office Action, the Office Action contends that "as claim 1 is written, the passage count is always zero or one since the passage count of two or more are disregarded. The predetermined area and the predetermined time period vary. However, the passage count is always zero or one." Applicants respectfully disagree. The passage count is not always zero or one, as asserted by the Office Action. Rather, if the predetermined time period is, for example 5 minutes, the passage count is incremented by one the first time a user passes within the predetermined area during the predetermined time period and is again incremented by one if the user passes within the predetermined area after that 5 minute period has elapsed. For example, a user could obtain a maximum passage count of five in a 25 minute period.

McGregor et al. is relied upon to teach "tracking and counting a mobile user's passing through a predetermined area over a certain time frame". McGregor et al., however, teaches away from obtaining a passage count as in the present invention. According to McGregor et al.,

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"The signals are correlated with individual increments of time during an extended time period of days or months... The data is collected in a digital memory for the prolong periods of time and can be dumped to a personal computer in the form of a spreadsheet compatible file for future analysis" McGregor et al. Abstract. Further, McGregor et al. fails to teach or suggest that "when the mobile client passes through the same transmission area two or more times within a predetermined period of time, the second passage and later within that predetermined time period are not counted." As neither Haitsuka et al. nor Cohen teach or suggest this feature, they fail to cure the deficiencies of McGregor et al. Thus, Applicants respectfully submit that Haitsuka et al., Cohen, and McGregor et al., whether taken alone or in combination, fail to teach or suggest all of the features of amended independent claim 1. For at least this reason, Applicants respectfully submit that amended independent claim 1, and independent claims 12 and 14-17, which recite similar features, patentably distinguish over the prior art and are in condition for allowance. Additionally, Applicants respectfully submit that dependent claims 2-4, 7, 9-11, and 18 patentably distinguish over the prior art for at least the same reasons as the independent claims from which they depend.

Further, independent claims 1, 12, and 14-17 have each been amended to recite "a fee for distributing advertising information throughout the predetermined advertising information transmission area is determined based on an amount of traffic in the predetermined advertising information transmission area, a time period in which the advertising information is distributed, or attributes of the predetermined advertising information transmission area in which the advertising information is distributed". Support for this amendment to independent claims 1, 12, and 14-17 can be found in the originally filed Specification, at least at page 22, lines 17-22.

Applicants respectfully submit that Haitsuka et al., Cohen, and McGregor et al. each fail to teach or suggest at least these feature. Thus Applicants respectfully submit that Haitsuka et al., Cohen, and McGregor et al., whether taken alone or in combination, fail to teach or suggest all of the features of amended independent claims 1, 12, and 14-17. For at least this reason, and those set forth above, Applicants submit that claims 1, 12, and 14-17 patentably distinguish over the prior art and are in condition for allowance. Additionally, Applicants respectfully submit that dependent claims 2-4, 7, 9-11, and 18 patentably distinguish over the prior art for at least the same reasons as the independent claims from which they depend.

MPEP 706.02(j) sets forth a guideline on the contents of a rejection under §103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

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reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143-2143.03 for decisions pertinent to each of these criteria." See MPEP 2142. Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. See *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001).

See MPEP 2143.01. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357; 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper)." In *In re Fulton*, 391 F.3d 1195, 1200-01, 73 USPQ2d 1141 (Fed. Cir. 2004), the court emphasized that the proper inquiry is "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination, not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available."

In particular, the nature of the problem to be solved must be such that it would have led a person of ordinary skill in the art with no knowledge of the claimed invention (i.e., at the time of the invention) to combine the prior art teachings in the manner claimed. See, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Applicants respectfully submit that here is no suggestion or motivation, either in Haitsuka et al., in Cohen, in McGregor et al., or in the knowledge generally available to one of ordinary skill in the art at the time the claimed present invention was made, to modify Haitsuka et al. based upon Cohen and McGregor et al. This is not surprising given that Haitsuka et al. is directed to the monitoring of individual internet usage and, more specifically, monitoring the on-line activities of an on-line user as to obtain information to target advertisements to the user; Cohen is directed to a mobile display system including one or more movable billboard displays that can be moved from location to location; and McGregor et al. is directed to a customer activity monitor which monitors the presence of entities over extended time periods and collects the data for future analysis.

Applicants note that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). See *W.L. Gore & Assocs., Inc. v.*

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Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

Accordingly, a prima facie obviousness cannot be established based upon Haitsuka et al., Cohen, and McGregor et al., because Cohen and McGregor et al. fail to disclose or suggest any motivation to modify Haitsuka et al. in the manner suggested by the Office Action. Applicants respectfully submit that, in contrast to independent claims 1, 12, and 14-17, neither Haitsuka et al., nor Cohen, nor McGregor et al. teaches or suggests the concept of not incrementing the passage count of a mobile client when it passes through the same transmission area two or more times within a predetermined period of time, and then transmitting advertising information based on the passage count of the mobile client in the transmission area and recited in independent claims 1, 12, and 14-17. The failure of these references to teach or suggest at least this feature proves fatal to establishing a prima facie case of obviousness against independent claims 1, 12, and 14-17, since MPEP §2142 requires that "To establish a prima facie case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Rejection of Claims 5 and 13

In the outstanding Office Action at pages 11-14, numbered item 4, claims 5 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Haitsuka et al. in view of Cohen in further view of McGregor et al. and further in view of U.S. Patent No. 6,332,127 to Bandera. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As noted above, McGregor et al. fails to cure the deficiencies of Haitsuka et al. and Cohen with respect to claims 1, 7, 12, and 18. Bandera is relied upon only to teach "incentives distinct from advertising" col. 3, lines 19-42. Accordingly, Applicant respectfully submits that Cohen, McGregor et al., and Bandera fail to cure all of the deficiencies of Haitsuka et al. As Haitsuka et al., Cohen, McGregor et al., and Bandera, taken alone or in combination, fail to teach or suggest all of the features of claims 5 and 13, Applicant respectfully submits that claims 5 and 13 patentably distinguish over the prior art and are in condition for allowance.

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Rejection of Claim 8

In the outstanding Office Action at page 14, numbered item 5, claim 8 was rejected as being unpatentable over Haitsuka et al. in view of Cohen in further view of McGregor et al. and further in view of U.S. Patent No. 6,360,221 to Gough. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As noted above, McGregor et al. fails to cure the deficiencies of Haitsuka et al. and Cohen. Gough is relied upon only to teach "that the transmission of advertising information to the client is omitted as instructed by the client" col. 6, lines 30-36. Accordingly, Applicant respectfully submits that Cohen, McGregor et al., and Gough fail to cure all of the deficiencies of Haitsuka et al. As Haitsuka et al., Cohen, McGregor et al., and Gough, taken alone or in combination, fail to teach or suggest all of the features of claim 8, Applicant respectfully submits that claim 8 patentably distinguishes over the prior art and is in condition for allowance.

Rejection of Claim 17

In the outstanding Office Action at pages 15-17, numbered item 6, claim 17 was rejected as being unpatentable over Haitsuka et al. in view of Cohen in further view of McGregor et al. and further in view of U.S. Patent No. 6,061,660 to Eggleston. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As noted above, McGregor et al. fails to cure the deficiencies of Haitsuka et al. and Cohen. Eggleston is relied upon to teach only "the utilization of awards points as an incentive and related to advertising purposes." Accordingly, Applicant respectfully submits that Cohen, McGregor et al., and Eggleston fail to cure all of the deficiencies of Haitsuka et al. As Haitsuka et al., Cohen, McGregor et al., and Eggleston, taken alone or in combination, fail to teach or suggest all of the features of claim 17, Applicant respectfully submits that claim 17 patentably distinguishes over the prior art and is in condition for allowance.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for

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allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 30 May 2006

By: Allison Olenginski
Allison Olenginski
Registration No. 55,500

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

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on 30 May, 2006

STAAS & HALSEY

By: Allison Olenginski

Date: 30 May 2006